

ESTTA Tracking number: **ESTTA121226**

Filing date: **01/24/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78897251
Applicant	Tele-Town Hall, LLC
Applied for Mark	TELE TOWN HALL
Correspondence Address	JEFFREY D. HARTY MCKEE, VOORHEES & SEASE, PLC 801 GRAND AVE STE 3200 DES MOINES, IA 50309-8009 UNITED STATES patatty@ipmvs.com
Submission	Reply Brief
Attachments	Tele Town Hall reply brief_78-897251.pdf ( 6 pages )(27970 bytes )
Filer's Name	Jeffrey D. Harty
Filer's e-mail	patatty@ipmvs.com
Signature	/Jeffrey D. Harty/
Date	01/24/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

---

IN RE: Tele-Town Hall, L.L.C.	)	
	)	
SERIAL NO: 78/897,251	)	Appeal No. _____
	)	
MARK: TELE TOWN HALL	)	
	)	
FILED: May 31, 2006	)	
	)	
LAW OFFICE: 111	)	
	)	

---

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

REPLY BRIEF

## TABLE OF CONTENTS

	Page
I.      TRANSPOSITION IS NOT PER SE CONFUSION.....	1
II.     DIFFERENT COMMERCIAL IMPRESSIONS IN THEIR ENTIRETIES .....	1
III.    CONCLUSION .....	4

## TABLE OF AUTHORITIES

CASES	Page
<i>Bank of America Nat'l Trust v. American Nat'l Bank</i> , 201 U.S.P.Q. 842 (TTAB 1978) .....	2
<i>Colgate-Palmolive Co. v. Carter-Wallace Inc.</i> , 167 U.S.P.Q. 529, 530 (CCPA 1970) .....	3
<i>Estate of Beckwith, Inc. v. Comm. of Patents</i> , 225 U.S. 538, 545-46 (1920) .....	2, 4
<i>In re General Electric Co.</i> , 134 U.S.P.Q. 190 (CCPA 1962) .....	3
<i>Lever Brothers Co. v. The Barcelone Co.</i> , 174 U.S.P.Q. 392, 292 (CCPA 1992) .....	3
<i>The Falk Corp. v. Toro Manufacturing Corp.</i> , 181 U.S.P.Q. 462, 467 (CCPA 1974) .....	3

Dear Sir:

Please enter the following Reply Brief into the record. It responds to the Examining Attorney's request to affirm the refusal of registration of the above-stated mark over U.S. Registration No. 2,800,397 ("the '397 mark"). The refusal to register Appellant's mark can only be affirmed if the well established anti-dissection rule is thrown out the window in favor of the Examining Attorney's piecemeal approach in finding similarity between the respective marks. Appellant urges the Board reverse the Examining Attorney's refusal to register Appellant's mark.

I. TRANSPOSITION IS NOT PER SE CONFUSION

The Examining Attorney offers in the Appeal Brief another rationale for refusal of Appellant's mark – transposition of terms. Examining Attorney's Appeal Brief, page 3. However, transposition of the words of a mark is not *per se* confusion. *See Bank of America Nat'l Trust v. American Nat'l Bank*, 201 U.S.P.Q. 842 (TTAB 1978) (stating "the fact that two marks are composed of reverse combinations of the same elements is not necessarily conclusive on the issue of likelihood of confusion since registration may be permitted if the transposed marks create distinctly different commercial impressions."). The transposition rationale posed by the Examining Attorney takes us back to the commercial impression of the respective marks. As urged in Appellant's Appeal Brief, distinctly difference commercial impressions are created by the respective marks.

II. DIFFERENT COMMERCIAL IMPRESSIONS IN THEIR ENTIRETIES

The Examining Attorney once again hinges the refusal to register Appellant's mark on the argument that the respective marks create the same commercial impression. Appellant urges the Board to compare the marks in their entirety as the Supreme Court established in 1920. *See Estate of Beckwith, Inc. v. Comm. Of Patents*, 225 U.S. 538,

545-46 (1920) ("The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason, it should be considered in its entirety."). When the marks are compared in their entireties, the only conclusion that can and should be reached is that the marks create distinctly different commercial impressions. The simple fact that the marks have some similarities is not enough to support that they are similar overall. There are significant differences in their appearance and pronunciation; thus the commercial impressions would be different. *See, e.g., The Falk Corp. v. Toro Manufacturing Corp.*, 181 U.S.P.Q. 462, 467 (CCPA 1974) (Difference between TOTO and TORUB contributed to a finding of no likelihood of confusion); *Lever Brothers Co. v. The Barcelone Co.*, 174 U.S.P.Q. 392, 292 (CCPA 1992) ("While appellant points out some similarities between the word ALL as it is used by both parties, inspection of the two marks [ALL and design and ALL CLEAR! and design] also shows some obvious difference. Considering appellee's mark in its entirety, we are convinced that there is no likelihood of confusion"); *Colgate-Palmolive Co. v. Carter-Wallace Inc.*, 167 U.S.P.Q. 529, 530 (CCPA 1970) ("The difference in appearance and sound of the marks in issue [PEAK and PEAK PERIOD] is too obvious to render detailed discussion necessary. In their entireties they neither look nor sound alike"); and *In re General Electric Co.*, 134 U.S.P.Q. 190 (CCPA 1962) (VULCAN and VULKENE not similar). As with the case at bar, the differences between Appellant's mark and the '397 mark overwhelm the similarities. These differences along with the differences in the services offered under the respective marks support the publication of Appellant's application as they are not competitors for the same type of business and, thus, would not impede either companies' commercial efforts.

Further, not once throughout the Examining Attorney's analysis for likelihood of confusion are the marks in their entirety ever compared to one another with respect to connotation, appearance, pronunciation or commercial impression. Of particular note is the manner in which the Examining Attorney dissects the first part of the '397 mark – THT – from the remainder of the mark and discards it relative to any further analysis other than the conjecture that it is "understood to stand for TOWNHALL TELECONFERENCING." Examining Attorney's Appeal Brief, page 3. Whether or not this conjecture is true on the part of the Examining Attorney, THT is part of the legal, registered mark of the '397 mark and is to be considered in looking at the mark in its entirety. What is more, the term THT is a distinctive portion of the '397 mark and appears at the beginning of the mark, which strongly militates against a finding of likelihood of confusion.

Not only does the Examining Attorney impermissibly dissect the marks, the individual words within the marks are dissected further. For example, the word portion of the '397 mark is THT TOWNHALL TELECONFERENCING which the Examining Attorney dissects into "THT" – "TOWN" – "HALL" – and "TELE" – to support the finding of likelihood of confusion with Appellant's mark, TELE TOWNHALL. Although it is not impermissible to look at a mark and, for rational reasons, give more or less weight to a particular feature, the Examining Attorney goes well beyond any reasonable and permissible standard in a likelihood of confusion analysis. It has been well established, since as early as 1920, that the marks must be compared in their entireties. *See Estate of Beckwith*, 225 U.S. at 545-46. To hold other than reversing the Examining Attorneys' refusal to register would be pulling the rug out from under well established law than has been in place for nearly 85 years.

III. CONCLUSION

For the above-stated reasons, as well as Appellant's comments in its Appeal Brief, Appellant's mark TELE TOWN HALL is not confusingly similar to the '397 mark. Appellant therefore respectfully requests that the Examining Attorney's refusal to register Appellant's mark be reversed and the application be forwarded for publication.

Respectfully submitted,

Jeffrey D. Harty  
McKEE, VOORHEES & SEASE, P.L.C.  
Attorneys of Record

801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
515-288-3667